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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,489	01/23/2001	Lisa Joanne Drewe	41577/252464	5644
23370	7590	03/16/2007		
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER CHUNDURU, SURYAPRABHA	
			ART UNIT 1637	PAPER NUMBER
			MAIL DATE 03/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/744,489

Applicant(s)

DREWE ET AL.

Examiner

Suryaprabha Chunduru

Art Unit

1637

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 27 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: NONE.  
Claim(s) objected to: NONE.  
Claim(s) rejected: 1,2,5,6,8-12,18,19 and 22-26.  
Claim(s) withdrawn from consideration: NONE.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

*Suryaprabha Chunduru*  
SURYAPRABHA CHUNDURU 3/15/07  
PRIMARY EXAMINER

Suryaprabha Chunduru  
Primary Examiner  
Art Unit: 1637

Continuation of 5. Applicant's reply has overcome the following rejection(s): claims 6, 22-24 rejected under 35 USC 103(a) as being obvious over Vary et al. in view of Egholm et al.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' amendment and arguments are fully considered and found persuasive in part. Applicants' amendment to claim 6 is fully considered and found persuasive and the rejection is withdrawn herein. However, the currently amended claim 6 and its dependent claims 22-24 are within the scope of the rejection applied to claims 1-2, 5, 8-9, 12. Therefore the currently amended claim 6 and the dependent claims 22-24 are rejected herein under 35 USC 103(a) over Vary et al. in view of Egholm et al. and Livak et al. as applied to claims 1-2, 5, 8-9, 12.

With regard to rejection of claims 1-2, 5, 8-9, 12 under 35 USC 103(a) Applicants' arguments are found unpersuasive. Applicants argue that the stability of a triplex formed between the amplified target sequence and the PNA would be so high that it would effectively clamp further amplification of the product and assert that one skilled in the art would have avoided the use of a PNA probe during amplification because it would be technically disadvantageous to use a PNA probe during amplification of a target sequence as noted by Egholm. Applicants' further argue that the scientific literature after the present method, surprisingly found that nucleic acid amplification can be achieved in the presence of a complementary PNA and assert that for the reasons above the rejection should be withdrawn. Applicants' arguments are fully considered and found unpersuasive. As noted in the MPEP 2112 "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). >In *re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004). Therefore the previously unappreciated property (disadvantageous of using a PNA during amplification) and a surprising finding or a new use of PNA during amplification does not render the old composition patentable since the unknown property is inherent in said PNA probe. Examiner notes that the instant claim 1 requires the use of a PNA probe during amplification and the arguments that one skilled in the art would have avoided are contradictory because in spite of its disadvantages the instant invention uses a PNA probe during amplification. This clearly indicates that as noted in MPEP 2112, the new property of PNA is inherent. Therefore the rejection is maintained and the newly amended claim 6 and its dependent claims are herein rejected under the same ground of rejection as applied to the claims 1-2, 5, 8-9, 12.

With regard to the rejection of claims 10-11, 18-19, Applicants' arguments are found unpersuasive. As discussed above the disadvantages of using PNA probe during amplification and a surprising new property of the old composition does not render the instant claims patentable. Applicants further argue that the combination of Graham would inhibit amplification, and the reference teaches away from the use of PNA during amplification. With regard to the arguments based on teaching away, it is noted that MPEP 2145, "A prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness; however, 'the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.'" *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994), a teaching away, is a significant factor to be considered as "teaching in". In the instant context the use of PNA probe during amplification is obvious over the cited prior art and it is obvious to modify the method with a waveguide detector as taught by Graham as discussed in the previous rejection. Therefore the rejection is maintained herein.

With regard to the rejection of claims 25-26 drawn to a kit, Applicants' amendment and arguments are fully considered and found unpersuasive because as noted in MPEP 7.37.09, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The amendment reciting the intended use of PNA does not differ from the prior art cited. Therefore the instant amendment did not change the scope of the product claims and the rejection is maintained herein.